UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF RHODE ISLAND

CONSORZIO DEL PROSCIUTTO DI SAN DANIELE,	)	
Plaintiff-Counterclaim Defendant,	)	C.A. No. 07-039 ML
v.	)	
DANIELE, INC.,	)	
Defendant-Counterclaim Plaintiff	)	

PLAINTIFF/COUNTERCLAIM DEFENDANT'S
STATEMENT OF CLAIMS

Pursuant to LR Cv 16(c), Plaintiff-Counterclaim Defendant Consorzio del Prosciutto di San Daniele ("Plaintiff") submits the following statement of the elements of its claims. Plaintiff asserted three claims and one affirmative defense against Defendant-Counterclaim Plaintiff Daniele, Inc. ("Defendant"): (1) breach of contract; (2) false designation of origin; and (3) trademark infringement; and (4) unclean hands.

A. Jurisdiction

This Court has subject matter jurisdiction under 28 U.S.C. § 1331 and § 1338(a), in that the matter arises under the Acts of Congress relating to trademarks and unfair competition and under 28 U.S.C. § 1332 in that the matter in controversy exceeds the sum or value of $75,000, exclusive of interest and costs, and is between citizens of a State and citizens or subjects of a foreign state. Further, the Court has supplemental jurisdiction over Count I of the Complaint asserting a breach of contract claim under 28 U.S.C. § 1367.

B. Venue

Venue is proper in this District because Defendant resides in this District and because a substantial part of the events or omissions giving rise to the claims alleged occurred in this District. *See* 28 U.S.C. § 1391(b)(1) and (b)(2).

C. Claims and Affirmative Defenses

1. Breach of Contract. To prevail on its breach of contract claim, Plaintiff must prove the existence of a contract, a breach and damage. *Petrarca v. Fidelity & Cas. Ins. Co.*, 884 A.2d 406, 410 (R.I. 2005). The Court should order specific performance where monetary damages will not provide adequate compensation. *See Yates v. Hill*, 761 A.2d 677, 679 (R.I. 2000).

2. False Designation of Origin. To prevail on its false designation of origin claim, Plaintiff must show that there is a likelihood of confusion as to (a) the geographic location where Defendant's prosciutto is produced, (b) an "affiliation, connection or association" between Defendant's prosciutto and a geographic place or entity or (c) the "origin, sponsorship or approval" of Defendant's prosciutto by a geographic place or entity. *See Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1891 (TTAB 1998); *Black Hills Jewelry Mfg. Co. v. Gold Rush, Inc.*, 633 F.2d 746 (8th Cir. 1980), *aff'g* 489 F. Supp. 754 (D.S.D. 1980). In order to prove a likelihood of confusion, Plaintiff must prove that (1) the term used by Defendant is a geographic term; (2) the use of the term would make people believe that Defendant's prosciutto came from the geographic place denoted by the term; and (3) Defendant's prosciutto did not in fact come from there. *See, e.g., Scotch Whiskey*

Association v. Barton Distilling Company, 489 F.2d 809 (7th Cir. 1973), *aff'g* 338 F. Supp. 595 (N.D.Ill. 1971); *Black Hills Jewelry Mfg.*, *supra*.

3. Trademark Infringement. To prevail on its trademark infringement claim, Plaintiff must show Defendant's unauthorized use in commerce of a term that so resembles Plaintiff's prior, valid federal trademark as to be likely to cause confusion. *International Association of Machinists v. Winship Green*, 103 F.3d 196 (1st Cir. 1996); *Baker v. Simmons Co.* 307 F. 2d 458 (1st Cir. 1962). In order to determine likelihood of confusion, courts weigh factors including: similarity of the marks; similarity of the goods; channels of trade and advertising; classes of prospective purchasers; actual confusion; intent; and strength of Plaintiff's mark. *Winship Green*, *supra*.

4. Unclean Hands. Plaintiff must show misconduct directly related to the merits of the controversy between the parties. *Texaco Puerto Rico, Inc. v. Dep't of Consumer Affairs*, 60 F.3d 867, 880 (1st Cir. 1995).

/s/ Matthew F. Medeiros______________

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Counsel for Plaintiff/Counterclaim Defendant

Dated: May 4, 2007

CERTIFICATION

I hereby certify that on May 4, 2007, a copy of the foregoing Plaintiff/Counterclaim Defendant's Statement of Claims was filed electronically. Notice of this filing will be sent by e-mail to all parties by operation of the Court's electronic filing system, or by e-mail or to anyone unable to accept electronic filing as indicated on the Notice of Electronic Filing. Parties may access this filing through the Court's CM/ECF System.

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/s/ Matthew F. Medeiros______________